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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,227	01/08/2002	Bernd Riedl	BAYER 15(1)	5714

23599 7590 10/31/2002

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EXAMINER

DESAI, RITA J

ART UNIT	PAPER NUMBER
1625	6

1625

DATE MAILED: 10/31/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,227

Applicant(s)

RIEDL ET AL.

Examiner

RITA J. DESAI

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____ .
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) ____ is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) 1-67 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ .
- 4) Interview Summary (PTO-413) Paper No(s). ____ .
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

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DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-,67 all in part , drawn to compounds pharmaceutical compositions and methods of treating using compounds of Formula I, wherein , A is -L-M-L' , wherein M is an Oxygen or Sulfur, L is a pyridinyl and L' is a phenyl, pyridinyl or a pyrimidinyl and B is a phenyl substituted atleast by a tert butyl group or a trifluoromethyl.

Group II , claim(s) 1-67 in part , drawn to compounds , pharmaceutical compositions and method of treating using compounds of formula I, wherein , A is -L-M-L' , wherein M is Oxygen or Sulfur, L is a pyridinyl and L' is a phenyl, pyridinyl or a pyrimidinyl and B is a phenyl substituted atleast by a tert butyl group or a trifluoromethyl.

Group III, claim(s) 1-59,62-65 in part , drawn to compounds , pharmaceutical compositions and method of treating using these compounds of formula I , wherein A is -L-M-L' , wherein M is an Oxygen or Sulfur, L is a pyrimidinyl and L' is a phenyl, pyridinyl or a pyrimidinyl and phenyl substituted atleast by a tert butyl group or a trifluoromethyl.

Group IV, claim(s) 1-67 in part , drawn to compounds pharmaceutical compositions and method of treating using these compounds of formula I, wherein all the other substituents are same as in group I except L is a phenyl instead of a pyridinyl.

Group V, claim(s) 1-59,62-65 in part, drawn to to compounds pharmaceutical compositions and method of treating using these compounds of formula I , wherein all the other substituents are same as in group I except L is a pyrimidinyl instead of a pyridinyl.

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Group VI, claim(s) 1-67 in part, drawn to compounds pharmaceutical compositions and method of treating using these compounds of formula I, wherein all the other substituents are same as in group I except that M is -N-C=O. (amido group).

Group VII, claim(s) 1-67 in part, drawn to compounds pharmaceutical compositions and method of treating using these compounds of formula I, wherein all the other substituents are same as in group II except M is -N-C=O (amido) group.

Group VIII, claim(s) 1-59, 62-65 in part drawn to compounds, pharmaceutical compositions and method of treating using these compounds of formula I, wherein all the substituents are same as in group III except that M is a -N-C=O (amido) group.

Group IX, claim(s) 1-67 in part, drawn to compounds pharmaceutical compositions and method of treating using these compounds of formula I, wherein all the other substituents are same as in group I except that M is different that group I and group VI. A further election of a single disclosed species is required.

Group X, claim(s) 1-67 in part, drawn to compounds pharmaceutical compositions and method of treating using these compounds of formula I, wherein all the other substituents are same as in group II, and V except that M is a different group. A further election of a single disclosed species is required.

Group XI, claim(s) 1-59, 62-65 in part, drawn to compounds pharmaceutical compositions and method of treating using these compounds, of formula I, wherein all the other substituents are same as in group III, and VI except that M is a different group. A further election of a single disclosed species is required.

Group XII, claim(s) 1-59, 62-65 in part, drawn to compounds pharmaceutical compositions and method of treating using these compounds, of formula I, wherein all B is 5 membered ring and L is also a 5 membered ring. A further election of a single disclosed species is required.

Group XIII, claim(s) 1-59, 62-65 in part drawn to compounds pharmaceutical compositions and method of treating using these compounds of formula I, wherein B is a tricyclic ring. A further election of a single disclosed species is required.

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Group XIV, claim(s) 1-59,62-65 in part, drawn to compounds pharmaceutical compositions and method of treating using these compounds of formula I, wherein B is 5 membered hetero ring. A further election of a single disclosed species is required.

Group XV, claim(s) 1-59,62-65, drawn to compounds pharmaceutical compositions and method of treating using these compounds of formula I, wherein all the other substituents are different than given in the above groups. A further election of a single disclosed species is required.

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

(f) "Markush Practice." The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

(i) When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity, *and*

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

(ii) In paragraph (f)(i)(B)(1), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of the existing prior art. The structural element may be a single component or a combination of individual components linked together.

The different A, B with the L, L', M's and the various hetero rings and substituents have so many variables with the heterocyclic and non-hetero groupings, they have different bonding and properties, and have achieved a different status in the art, and is burdensome to search and hence are objected to on the grounds that they lack a common nucleus. The terms A, L, L', M, and the various het groups and rings, are so broad in scope that a prior art reference anticipating the claims with respect to one member under 35 USC 102(b) would not render obvious the same claims under 35 USC 103a with respect to another member.

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Applicants common core is a urea group.

A preliminary search on applicants core gave numerous iterations indicating that the core is not applicants contribution over the prior art, and it did not run to completion!



> s 11

SAMPLE SEARCH INITIATED 15:49:03 FILE 'REGISTRY'
SAMPLE SCREEN SEARCH COMPLETED - 21815 TO ITERATE

4.6% PROCESSED 1000 ITERATIONS 50 ANSWERS
INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)
SEARCH TIME: 00.00.01

FULL FILE PROJECTIONS: ONLINE **INCOMPLETE**
BATCH **COMPLETE**
PROJECTED ITERATIONS: 427482 TO 445118

Thus applicants core is not a contribution over the prior art and hence lack of unity /restriction is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Mr. Traverso on 10/24/2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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If applicant 's traverse on the grounds that the inventions are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the groups to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art , the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

Applicants are required to amend the claims to the elected group. Applicants preserve their right to file a divisional on the canceled non-elected claims , without prejudice in due course.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA J. DESAI whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday,9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A handwritten signature in black ink, appearing to read "R. Desai", with a horizontal line underneath the name.

R.D.
October 24, 2002